

79 of which have been newly added. Based upon the foregoing claim amendments and the following remarks, reconsideration of the application is respectfully requested.

Kakinoki Patent Not Prior Art

The Examiner indicated that he considered the Fig. 5 card unit disclosed in U.S. Patent No. 5,391,094 to Kakinoki et al. ("Kakinoki card unit") to presumably be §102(a) prior art. Applicants agree with the Examiner, but only to the extent that Kakinoki card unit was known by others in Japan prior to November 20, 1992. To qualify as prior art under §102(a), however, a device must be known in the United States prior to the date of the subject invention, and thus, it is irrelevant that the Kakinoki card unit was known in Japan. In the instant case, November 12, 1993, the actual U.S. filing date of U.S. Patent No. 5,391,094, would be considered the prima facie date that the Kakinoki card unit was known by others in the United States. As such, absent other evidence, the Kakinoki card unit cannot be considered to be §102(a) prior art to the claims of the instant application, which properly claims priority back to November 12, 1993.

Claim Rejections-Double Patenting

The Examiner rejected claims 34-39 and 68-71 as being unpatentable over claims 1-19 of U.S. Patent No. 5,411,405 to McDaniels et al. under the doctrines of nonstatutory obviousness-type double patenting and nonstatutory non-obviousness-type double patenting. Applicants respectfully submit that the attached Terminal Disclaimer overcomes the double patenting rejections of claims 34-39 and 68-71, and as such, respectfully request the Examiner to withdraw the double patenting rejections of these claims.

Claim Rejections-35 U.S.C. §103

Kakinoki Card Unit

The Examiner rejected claims 34-39 and 68-71 as being obvious over the Kakinoki card unit in view of U.S. Patent No. 4,611,875 to Clarke et al. ("Clark"), U.S. Patent No. 4,241,974 to Hardesty ("Hardesty"), and a research disclosure entitled "Integrated Services Digital Network (ISDN) Cable Terminator/Filter Device," and published by Kenneth Mason Publications Ltd., England in September 1990 ("Research Disclosure"). Applicants respectfully traverse these rejections, since none of the prior art references, alone or in combination, disclose, teach or suggest the combination of elements required by the claims.

Applicants initially note that although not prior art to claims 34-39 and 68-71, the Kakinoki card unit will be considered as prior art for the purposes of this discussion in order to expedite the prosecution of this application. Turning now to the prior art rejections, the Examiner indicated that it would have been obvious to replace the network control unit 50 of the Kakinoki card unit with the removable adapters described in Clarke, Hardesty, and the Research Disclosure. These references, however, only teach that adapters can be removably attached to a signal utilizing device itself or a line connected to the signal utilizing device, e.g., a telephone station (Clarke), standard telephone line (Hardesty), or ISDN cable (Research Disclosure). There is no teaching or suggestion, whatsoever, that any of the adapters disclosed in these references could be removably attached to PCMCIA compliant communications devices that are received by the signal utilizing device.

Importantly, none of the devices to which the prior art adapters are connected appear to have space limitations that ones of ordinary skill have to ordinarily address when adding features to PCMCIA devices. Applicants, on the other hand, have developed a means for removably

attaching a connector housing to a PCMCIA device, while still complying with the spatial dimensions dictated by the PCMCIA standards. It is additionally noted that Applicants' invention provides a variety of advantages to the PCMCIA connector industry, e.g., the ability to interchange different connector housings with the PCMCIA device, or replace damaged connector housings without replacing the entire PCMCIA device (see specification, page 34, line 20 to page 36, line 10, and page 57, lines 3-12).

Additionally, claim 68 requires the housing means to include a recess for receiving a plug. There is no teaching whatsoever by Clarke, Hardesty or the Research Disclosure as to how a plug recess could be incorporated into the adapters disclosed in these references, while still complying with the PCMCIA spatial requirements.

Thus, Applicants submit that claims 34-39 and 68-71 are not obvious over the combination of the Kikinoki card unit, Clarke, Hardesty, and the Research Disclosure, and thus, respectfully request the Examiner to withdraw his rejections of these claims with respect to the combination of these references.

Aldous

The Examiner further rejected claims 34-39 and 68-71 as being obvious over U.S. Patent No. 5,183,404 to Aldous et al. ("Aldous") in view of Clarke, Hardesty, and the Research Disclosure. Applicants respectfully traverse these rejections, since none of the prior art references, alone or in combination, disclose, teach or suggest the combination of elements required by the claims.

Specifically, the Examiner stated that it would have been obvious to combine the card units illustrated in Figs. 3, 5, 7, 8, 9, and 15 of Aldous with the removably attached adapters illustrated in the other three references. Applicants submit, however, that Aldous is cumulative

to the Kakinoki card unit, and adds nothing to the plain deficiencies previously discussed with respect to the Kakinoki card unit. That is, Aldous merely discloses a card unit that is adapted to receive a cabled adapter similar to that of the Kakinoki card unit.

Thus, Applicants submit that claims 34-39 and 68-71 are not obvious over the combination of the Aldous, Clarke, Hardesty, and the Research Disclosure, and thus, respectfully request the Examiner to withdraw his rejections of these claims with respect to the combination of these references.

Claim Amendments and New Claims

Applicants would like to point out that the claims amendments and additions were not made in response to the Examiner's prior art rejections, but were rather made to either broaden the claims, improve the readability of the claims, or to provide symmetry between claim sets that depend from claims 34 and 39.

Applicants submit that added claims 72-79 are supported by the specification, as originally filed, and are patentable over the cited prior art for the reasons stated herein.

Conclusion

Based upon the foregoing amendments and remarks, it is respectfully submitted that the

application is now in condition for allowance. Should the Examiner have any questions or comments, she is invited to call the undersigned at (949) 567-2300.

Respectfully submitted,

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Version With Markings To Show Changes Made

34. (Thrice Amended) A communications device, the communications device compliant with PCMCIA communications standards [for the height and length of a Type III card] and which can be received by a signal utilizing device, comprising:

connector housing means for interfacing with a communications line;

body means for making operative and removable connection with the signal utilizing device;

means for removably attaching the connector housing means to the body means such that the connector housing means and the body means are held together as a unitary module; and

means for conveying a communications signal between the communications line and a signal utilizing device.

39. (Thrice Amended) A communications device, the communications device compliant with PCMCIA communications standards [for the height and length of a Type III card] and which can be received by a signal utilizing device, comprising:

a connector housing adapted for interfacing with a communications line;

^{in place}
a card-body adapted for making operative and removable connection with the signal utilizing device;

^{card}
means for removably attaching the connector housing means to the body means such that ^{card} the connector housing means and the body means are held together as a unitary module; and

means for conveying a communications signal between the communications line and a signal utilizing device.

68. (Once Amended) A communications device as defined in claim [39] 34 wherein the means for conveying a communications signal comprises:

at least one recess means provided in the connector housing means, the recess means having dimensions such that a plug is closely received therein;

a first electrical conductor provided in the recess means, the first electrical conductor being positioned such that it makes electrical continuity with [the] a first electrical contact in the plug when the plug is received by the recess means;

a second electrical conductor provided in the recess means, the second electrical conductor being positioned such that it makes electrical continuity with [the] a second electrical contact in the plug when the plug is received by the recess means; and

means for conveying any electrical signal present on the first and second electrical contact to the communications device.

70. (Once Amended) A communications device as defined in claim [39] 69 wherein the [connector housing means comprises a] RJ-xx series plug is selected from the group consisting of [the] RJ-11, RJ-12, and RJ-45 plugs.

71. (Once Amended) A communications device as defined in claim [39] 34 wherein the communications device comprises a PCMCIA [Type III] compliant communications card.